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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,806	06/27/2005	Gerhardus Engbertus Mekenkamp	NL021459	9274
24737	7590	05/21/2007		
PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510			EXAMINER BRIENEN, CARL	
			ART UNIT	PAPER NUMBER
			2188	
			MAIL DATE	DELIVERY MODE
			05/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,806

Applicant(s)

MEKENKAMP ET AL.

Examiner

Carl Brien

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 27 June 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-10 have been examined and are pending.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 27 June 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The disclosure is objected to because of the following informalities:

Various acronyms are used throughout the specification without first defining what they stand for. For example the first use of "DVD" should define it as "Digital Video Disk (DVD)" or as appropriate. The other acronyms found throughout the specification should be fixed as well.

The use of the trademarks "Panasonic" and "Blu-Ray" have been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Appropriate correction is required.

Drawings

5. The drawings are objected to because they difficult to follow without labels on the drawings. In order for the drawings to easily convey the invention, they need labels on the items in the drawings, especially when the drawing is a flowchart of a method. Although the drawings do contain reference numbers as required, a small text label is requested so that a reader can follow each step in the method and identify each object in the system without searching the specification.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claims 1-9 are objected to because of the following informalities:

Claim 1 states "providing a user interface for selecting a content item," and "retrieving a further content item related to **the content item**." The content item that is related to (bolded) in the previous sentence could be referring to the first content item listed, or the further content item. It is assumed to be referring to the first content item, but there is no specific antecedent basis for it. Additionally, claims 2 and 7 contain "the content item" which may be one of two content items previously presented.

Several claims contain grammatical errors or are worded in such a way as to be unclear as to what is actually intended to be claimed.

Claim 1 states "storing content on the removable medium, characterized in that: further comprised is the step..." It is not clear how the steps further characterize the method or the removable medium and if the medium is comprising the steps or if the method is. Claim 8 has similar issues when it's claimed "content item stored on a storage means (33), characterized in that: further comprised is a network interface."

Any claims not explicitly mentioned are objected for being dependent upon an objected claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 states, "characterized by further comprising the step of authenticating (11) to the system." It is unclear what is meant by "authenticating to the system." The act of authenticating can be seen as the act of verifying someone or something as being who they say they are. In this claim, nothing is specifically being authenticated and it is unclear how something or someone can be authenticating to the system.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 fails to place the invention squarely within one statutory class of invention. On page 5, lines 31-33 of the instant specification, applicant has provided evidence that applicant intends the "Computer program" to include signals including those "downloadable via a network, such as the Internet". As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefor not a composition

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of matter. Additionally, a physical medium cannot be executed as the computer program product is in claim 10, but the instructions stored in the medium. This provides evidence that the computer program product is not a physical medium, but software, abstract idea, which also fails to fall into one of the four categories of invention.

Examiner recommends changing "computer program product enabling, upon its execution," to "computer storage medium embodying program instructions that when executed, cause" to overcome the 35 USC 101 rejection of claim 10. Other variations may be acceptable, but the highlight of the example shows that the computer program product is a physical medium, which does not include signals.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Millard, WO 02/067125.

Claim 1

Millard discloses:

A method of storing content on a removable medium, the method comprising the steps of: providing (1) a user interface for selecting a content item stored on a storage means; ([0014]-[0017], [0067])

and storing (5) content on the removable medium, ([0014]-[0017], [0031], [0042], [0067])

characterized in that: further comprised is the step of retrieving (3) a further content item related to the content item from a system on a network using an identification of the content item; ([0031], [0042], [0071]-[0072])

and the step of storing (5) content on the removable medium comprises storing the further content item on the removable medium. ([0031], [0042])

Claim 2

The rejection of claim 1 is incorporated and further Millard discloses:

characterized in that the step of storing (5) content on the removable medium further comprises storing the content item on the removable medium. ([0014]-[0017], [0031], [0042], [0067])

Claim 3

The rejection of claim 1 is incorporated and further Millard discloses:

characterized by further comprising the step of providing (9) a user interface for paying for the further content item. ([0043])

Claim 4

The rejection of claim 1 is incorporated and further Millard discloses:

characterized by further comprising the step of authenticating (11) to the system. ([0031], [0042]-[0043])

Claim 5

The rejection of claim 1 is incorporated and further Millard discloses:

characterized in that the step of retrieving (3) a further content item comprises retrieving at least one of: a removed scene, an added scene, a biography, a documentary, an image, an advertisement, a menu, a menu comprising an advertisement, and a trailer. ([0036])
When a season of a sitcom is retrieved wherein the storage medium did not have all of the episodes, "added scenes" are said to be retrieved, which is one of the listed items.

Claim 6

The rejection of claim 1 is incorporated and further Millard discloses:

characterized in that the step of storing (5) content on the removable medium further comprises storing a menu on the removable medium. ([0036] lines 29-31, [0072])

Claim 7

The rejection of claim 1 is incorporated and further Millard discloses:

characterized in that the step of retrieving (3) a further content item comprises retrieving a part of a master copy of the content item, the part not being present in the content item. ([0036], [0072]) If the content item is a television series, or a season of races, the episodes or races that the user does not have can be downloaded from the "master copy."

Claim 8

Millard discloses:

An electronic device (21) for storing content on a removable medium, the electronic device comprising: a writer (23) able to store content on the removable medium; (FIG. 6 #616, [0039])
and a control unit (25) able to use an input device and an output device to enable a user to select a content item stored on a storage means (33), (FIG. 6 #614, #618, [0014]-[0017], [0039], [0067])
characterized in that: further comprised is a network interface (27); (FIG. 7, #704, [0044])
the control unit (25) is able to use the network interface (27) to retrieve a further content item related to the content item from a system on a network using an identification of the content item; ([0031], [0042], [0071]-[0072])
and the control unit (25) is able to use the writer (23) to store the further content item on the removable medium. (FIG. 6 #614, [0039])

Claim 9

The rejection of claim 8 is incorporated and further Millard discloses:

characterized by further comprising the storage means (33). ([0014]-[0017], [0067])

Claim 10

The rejection of claim 1 is incorporated and further Millard discloses:

A computer program product enabling, upon its execution, a
programmable apparatus to function as an electronic device for
storing content on a removable medium, comprising functions for:
(FIG. 6 #612, [0039])
providing a user interface for selecting a content item stored on a storage
means; ([0014]-[0017], [0067])
retrieving a further content item related to the content item from a system
on a network using an identification of the content item; ([0031],
[0042], [0071]-[0072])
and storing the further content item on the removable medium. ([0031],
[0042])

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Brien whose telephone number is (571)270-1394. The examiner can normally be reached on M-T 8:30-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner: Carl Brien
Date: May 15, 2007


HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
5-16-07